

Serial No. 09/978,516

REMARKS

It should be appreciated that the reasons provided by the Examiner to show that the alleged modifications to the combination of Juilfs and Golsch are based upon the hindsight knowledge of the present invention for the sole basis of attempting to meet the recitations of the claims. Specifically, the CAFC in *Environmental Designs, Ltd., v. Union Oil Co. of Cal.*, 218 USPQ 865, 870 (1983) stated:

All the pieces of the present invention were known in the art,... That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art. (Case citations.)

Further, the CAFC in *In re Gordon*, 221 USPQ 1125, 1127 (1984) stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)

Furthermore, the CAFC in *American Hoist & Derrick Co., v. Sowa & Sons, Inc.*, 220 USPQ 763, 771 (1984) quoted:

A patentable invention *** may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (Emphasis theirs.)

Similarly, the Court of Appeals for the Federal Circuit *In re Sernaker*, 702 F.2d 989, 217 USPQ 1, 5 (1983) stated:

We may assume, for purposes of this decision, that all the prior art references in this case are sufficiently related to one another and to a related and common art, that the hypothetical person skilled in the art must be presumed to be familiar with all of them. That being so, the next questions are (a) whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, and (b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication.

There is nothing in Juilfs and Golsch that suggests that further improvement could be made or would be desirable by making a stationery bumper of two pieces. Likewise, Kemper does not suggest that its teachings can be applied in other fields (including but not limited to that of Juilfs and Golsch). It is thus respectfully submitted that the rejection of claim 1 as amended to further define the bumper has been overcome.

Serial No. 09/978,516

Furthermore, claim 1 has been amended to further define the present invention in a manner to distinguish over Kemper. In particular, Kemper does not suggest that section 9 includes an enlarged end section as further defined in claim 1. Further, to attempt to further modify Kemper in a manner to meet the recitations of claim 1 would clearly not be suggested by Kemper or Juilfs and Golsch (which admitted do not show a composite bumper). Thus, it is respectfully submitted that the rejection of claim 1 as amended has been overcome for this separate and independent reason.

Further, claim 16 further defines the second bumper section. It is specifically requested that the Examiner identify what structure in Boothby corresponds to the first portion and the enlarged end section and corresponds to the T cross section in a manner recited in claim 16. It is respectfully submitted that although "plural bumper elements" are taught in Boothby, Boothby does not in any way suggest the recitations of claim 16. Thus, it is respectfully submitted that the rejection of claim 16 has been overcome for this separate and independent reason.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicant's nail driving tool which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner, whether those references are taken singly or in any combination, the Examiner is requested to allow claims 1-5, 7, 9-11 and 13-16, as amended, of the present application and to pass this application to issue.

As the undersigned has attempted to resolve any obstacles to allowance in a prior telephonic conference and has filed an RCE application, it is respectfully requested that the Examiner initiate a telephonic interview with the undersigned in the event that any obstacles to allowance are deemed to exist and to advance prosecution.

Respectfully submitted,

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